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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/734,301  | 12/15/2003  | Nathalie Mougin      | 05725.1324-00       | 2481             |
| 22852   | 7590        | 08/01/2008           |                     |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      |                     |                  |
| EXAMINER<br>SHIAO, REI TSANG  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1626  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 08/01/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/734,301

**Applicant(s)**

MOUGIN, NATHALIE

**Examiner**

REI-TSANG SHIAO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 12/15/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This application claims benefit of the foreign application:  
FRANCE 02 15858 with a filing date 12/13/2002.
2. Claims 1-91 are pending in the application.

***Information Disclosure Statement***

3. Applicant's Information Disclosure Statement filed on December 15, 2003 has been considered. Please refer to Applicant's copy of the 1449 submitted herein.

***Responses to Election/Restriction***

4. Applicant's election with traverse of Group I claims 1-90, in the reply filed on March 20, 2008 is acknowledged. Election of ethyl and styrenes as the at least two different monomeric residues as a single species is also acknowledged. The traversal is on the ground(s) that the Examiner has failed to show a serious burden exist to examine all the alleged species. This is found persuasive, in part, and the reasons are given *infra*.

Claims 1-91 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-90, drawn to a cosmetic composition comprising at least two different monomeric residues.

Groups I and II are related as product and process of use. The inventions

can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as use for preparing fabrics against mildew, or fungi, see Gagliardi et al. US 3,300,336 or see CAS: 66:66679.

The group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Claims 1-90 are prosecuted in the case. Claim 91 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-90 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the monomeric residues represents ethyl, styrenes, vinylpyridine, ethylenic sulphonic acids, or hydroxyalkyl (meth)acrylates, does not reasonably provide enablement for the monomeric residues without limitation (i.e., no named compounds), see claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Dependent claims 2-90 are also rejected along with claim 1 under 35 U.S.C. 112, first paragraph.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and

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8. the level of the skill in the art.

In the instant case:

**The nature of the invention**

The nature of the invention is a cosmetic composition comprising at least two different monomeric residues without limitation (i.e., no named compounds), see claim 1.

**The state of the prior art and the predictability or lack thereof in the art**

The state of the prior art is that a similar cosmetic composition comprising styrene and isoprene, see column 24-25 (i.e., claim 1) of Coolbaugh et al. US 6,312,672.

**The amount of direction or guidance present and the presence or absence of working examples**

The only direction or guidance present in the instant specification is the exemplified compounds of the Examples 2-9 on pages 45-51 of the specification. There is no data present in the instant specification for the monomeric residues without limitation.

**The breadth of the claims**

The instant breadth of the rejected claims is broader than the disclosure,

specifically, the instant claims include any monomeric residues without limitation.

**The quantity or experimentation needed and the level of skill in the art**

While the level of the skill in the chemical arts is high, it would require undue experimentation of one of ordinary skill in the art to resolve any monomeric residues without limitation. There is no guidance or working examples present for constitutional any monomeric residues without limitation. Incorporation of the limitation of the named compounds (i.e., claim 31) into claim 1 would overcome this rejection.

**6. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 5, recites the limitation "monomeric residues" is indefinite and ambiguous. It is unclear what the scope of "monomeric residues" is. The range of "monomeric residues" of claims 1 is from any carboxylic acid or any residues. Such breadth in view of the limited exemplification and the lack of scope of subject matter resulted from a search of the prior art indicated that the "scope" of claims 1-90 can not be ascertained. In view of the high degree of unpredictability of the chemical art and "monomeric residues" must be made available at the time the invention was made, i.e., filing of application, the broad scope can not be supplemented with future discovery of

new "corresponding derivative". It is recommended that "monomeric residues" be limited to the specific disclosure of compound, i.e., see claim 31 or pages 17-19 of the specification. Dependent claims 2-90 are also rejected along with claim 1 under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Mondet et al. US 6,113,930.

Applicants claim a cosmetic composition comprising at least two different monomeric residues (i.e., ethyl acrylate, styrene, hydroxyalkyl (meth)acrylate), see claim 1.

Mondet et al. disclose a cosmetic composition comprising at least one naturalized ioni-forming polymer (i.e., styrene) and an additional aqueous polymer dispersion (i.e., ethyl acrylate, 2-hydroxypropyl acrylate), see columns 8-10 (i.e., claim 36, 44, 16-17, 12-13 and 1). Therefore Mondet et al. cosmetic compositions anticipate the instant invention. Dependent claims 2-90 are also rejected along with claim 1 under 35 U.S.C. 102(b)



***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al. US 6,113,930.

Applicants claim a cosmetic composition comprising at least two different monomeric residues (i.e., ethyl acrylate, styrene, or hydroxyalkyl (meth)acrylate), see claim 1.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

Mondet et al. disclose a cosmetic composition comprising at least one naturalized ioni-forming polymer (i.e., styrene) and an additional aqueous polymer dispersion (i.e., ethyl acrylate, 2-hydroxypropyl acrylate), see columns 8-10 (i.e., claim 36, 44, 16-17, 12-13 and 1).

**Determination of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between instant claims and Mondet et al. is that the instant claims are silent on the scope of the two different monomeric residues. Mondet et al. cosmetic compositions overlap with the instant invention.

**Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)**

One having ordinary skill in the art would find the claims 1-90 prima facie obvious because one would be motivated to employ the product of Mondet et al. to obtain instant claimed composition comprising at least two different monomeric residues (i.e.,

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ethyl acrylate, styrene, or hydroxyalkyl (meth)acrylate). Dependent claims 2-90 are also rejected along with claim 1 under 35 U.S.C. 103(a).

The motivation to make the claimed compounds derived from the known compositions of Mondet et al. would possess similar activity (i.e., cosmetic compositions) to that which is claimed in the reference.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

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37 CFR 3.73(b).

Claims 1-90 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of Mondet et al. US 6,113,930. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

Applicants claim a cosmetic composition comprising at least two different monomeric residues (i.e., ethyl acrylate, styrene, hydroxyalkyl (meth)acrylate), see claim 1.

Mondet et al. claim a cosmetic composition comprising at least one naturalized ioni-forming polymer (i.e., styrene) and an additional aqueous polymer dispersion (i.e., ethyl acrylate or 2-hydroxypropyl acrylate), see columns 8-10 (i.e., claim 36, 44, 16-17, 12-13 and 1).

The difference between instant claims and Mondet et al. is that the instant claims are silent on the scope of the two different monomeric residues. Mondet et al. cosmetic compositions overlap with the instant invention.

One having ordinary skill in the art would find the claims 1-90 prima facie obvious because one would be motivated to employ the product of Mondet et al. to obtain instant claimed composition comprising at least two different monomeric residues (i.e., ethyl acrylate, styrene, or hydroxyalkyl (meth)acrylate). Dependent claims 2-90 are also rejected along with claim 1 under obviousness-type double patenting.

The motivation to make the claimed compounds derived from the known compositions of Mondet et al. would possess similar activity (i.e., cosmetic compositions) to that which is claimed in the reference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.  
Primary Patent Examiner  
Art Unit 1626

July 30, 2008